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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,163	08/30/2001	Thomas J. Schall	019934-000310US	9088

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[REDACTED] EXAMINER

JIANG, SHAOJIA A

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

1617

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<i>Supplemental Restriction</i> <b>Office Action Summary</b>	Application No.	Applicant(s)
	09/944,163	SCHALL ET AL.
Examiner	Art Unit	
Shaojia A. Jiang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 December 2002.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 5, 7-21 and 29-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 5, 7-21, and 29-34 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.      4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

## **DETAILED ACTION**

Applicant's preliminary amendment and response to the Restriction Requirement in Paper No. 5, submitted December 9, 2002, is acknowledged wherein claims 1-4, 6, and 22-28 have been cancelled, and claims 29-34 are newly submitted. Currently, claims 5, 7-21, and 29-34 are pending in this application.

The following is a Supplemental Election/Restrictions Requirement in view of the Applicant's preliminary amendment December 9, 2002 in Paper No. 9.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 5,7-13 drawn to a method for preventing dissemination of CMV in a human, classified in class 514, subclass 252.13 for example.
- II. Claims 14-21 drawn to a method for reducing cell motility in a CMV-infected cell, classified in class 514, subclass 252.13 for example.
- III. Claims 29-34 drawn to a method for treating CMV in a human, classified in class 514, subclass 252.13 for example.

Inventions Group I, II and III are unrelated to each other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the inventions are separate and distinct each from the other because they have different functions and different modes of

operation. The invention of Group I functions to prevent dissemination of CMV in a human. The invention of Group II functions to reduce cell motility in a CMV-infected cell. The invention of Group III functions to treat CMV in a human. Therefore, Group I, II and III have different functions and different modes of operation.

The search for all inventions would place an undue burden on the Office in view of the diversity in the field of search for each.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

***Election of Species***

This application contains claims directed to the following patentably distinct species of the claimed invention:

a plurality of disclosed patentably distinct compounds in Groups I-III (see above the restriction requirement); and

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of a single specific composition comprising a specified individual active compounds to be employed in Groups I-III

for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claims 5, 7-21, and 29-34 are generic to a plurality of disclosed patentably distinct species. The claims read on the employment of various compounds of the structural formula herein, with great diversity of chemical

structure classified across class 514, the search for all of which presents an undue burden on the Office. It is noted that a reference to one individual agent would not be a reference to another individual agent under 35 U.S.C.103.

A "specie" is a specific compound or treatment, with all parameters and/or substituent variables FULLY accounted for.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because the above restriction/election requirement is complex, a telephone call to applicant's agent to request an oral election was not made. See M.P.E.P Sec. 812.01.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.



S. Anna Jiang, Ph.D.  
Patent Examiner, AU 1617  
March 4, 2003